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10/29/1998

DALE BURNS

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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Art Unit: 3624

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GROUP 3600

*BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES*

Application Number: 09/182,033
Filing Date: October 29, 1998
Appellant(s): BURNS, DALE

Christopher B. Kilner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 2, 2005 appealing from the Office action mailed January 27, 2004.

Real Party in Interest

The Appellants' statement identifying the real party in interest contained in the brief is correct.

Related Appeals and Interferences

The Appellants' statement of the related appeals and interferences contained in the brief is correct.

Status of Claims

The statement of the status of the claims contained in the brief is correct.

Status of Amendments After Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

Summary of Invention

The summary of invention contained in the brief is correct.

Issues

The Appellant's statement of the issues in the brief is correct.

Grouping of Claims

The Appellants' statement of the grouping of the claims in the brief is correct.

Claims Appealed

The copy of the appealed claims contained in the Appendix (pages 24-29) to the brief is correct.

Prior Art of Record

U.S. Patent to Nichtberger et al. No. 4,882,675, filed on November 26, 1984, and issued on November 21, 1989, U.S. Patent to De Lapa et al. No. 5,822,735, filed on October 3, 1994, and issued on October 13, 1998, and U.S. Patent to Christensen No. 6,035,280, filed on April 10, 1996 and issued on March 7, 2000.

NEW PRIOR ART

No new prior art has been applied in this examiner's answer.

Grounds of Rejection

Claims 38 and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nichtberger et al. (U.S. Patent No. 4,882,675) hereinafter "Nichtberger" in view of De Lapa et al. (U.S. Patent No. 4,882,675) hereinafter "De Lapa" and further in view of Christensen (U.S. Patent No. 6,035,280).

With respect to the remaining pending claims, the examiner has been affirmed by the board of patents appeals and interferences.

Claims 38, and 48, Nichtberger teaches an electronic coupon processing system for eliminating a presentation of printed coupons at a checkout register (abstract) comprising:

a plurality of consumer identification means wherein each consumer identification is associated with a consumer (column 5, lines 1-16, and column 5, line 45 thru column 6, line 23);

a plurality of consumer accounts associated with said plurality of consumer identification means (column 11, lines 35-63, and column 17, line 49 thru column 18, line 43);

a database for storing information for each of said plurality of consumer accounts (column 29, lines 32-68);

at least one means separate from a checkout register for each consumer to enter unutilized coupon information from printed coupons in the consumer's possession into said associated consumer account based on input of the consumer's identification means so as to eliminate any need to present printed coupons at a checkout register (column 17, line 29 thru column 18, line 43);

at least one checkout register capable of collecting a consumer's purchase information, said register additionally being connected to said database (column 17, line 29 thru column 18, line 43);

means associated with said checkout register for reconciling the unutilized coupon information in each consumer's consumer account with the consumer's purchase information based solely on input of said consumer's consumer identification means (column 17, line 29 thru column 18, line 43);

means for updating said consumer's consumer account to reflect utilization of coupons (column 17, line 29 thru column 18, line 43), wherein one means for each consumer to enter unutilized coupon information from printed coupons provided for consumers to add unutilized coupon information into their consumer account (column 29, lines 56-68); and

means to add unutilized coupon information directly to consumer accounts (column 17, line 29 thru column 18, line 43, and column 29, lines 56-68).

Nichtberger fails to teach that the one means for each consumer to enter unutilized coupon information from printed coupons is the *only* means provided for consumers to add unutilized coupon information into their consumer account.

De Lapa teaches that the one means for each consumer to enter unutilized coupon information from printed coupons is the *only* means provided for consumers to add unutilized coupon information into their consumer account (column 9, line 32 thru column 12, line 34).

It would have been obvious to one of ordinary skilled in the art at the time the Applicant's invention was made to modify the teachings of Nichtberger to include that the one means for each consumer to enter unutilized coupon information from printed coupons is the *only* means provided for consumers to add unutilized coupon information into their consumer account, because it greatly improves the efficiency of the system by substantially reducing redemption and clearing costs, reducing fraud by destroying paper coupons by the CDR unit once inserted and read, also, it would integrate currently used system into the invention (see Nichtberger column 29, lines 56-68).

Both Nichtberger and De Lapa fail to teach the use of Internet to review unutilized coupon information in a consumer's account based on input of a consumer's consumer identification means.

Christensen teaches the use of Internet to review unutilized coupon information in a consumer's account based on input of a consumer's consumer identification means (column 11, line 62 thru column 15, line 36).

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Nichtberger to include the use of Internet to review unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means, because it provides convenience to the user by allowing the user to access coupons of interest quickly by performing a word search, and review,

select, and retrieve coupon information directly from the operations center (see Christensen column 13, lines 14-50).

Response to Argument

The Appellant raises various points in the argument's section of the appeal brief. Appellant traverses the board's affirmation of the rejection of claims 30-37, 39-47, and 49. However, Appellant's arguments with respect to the rejection of claims 30-37, 39-47, and 49 have been considered but moot in view of the board's affirmation mailed on November 18, 2002. No further response on these claims is deemed necessary by the examiner.

With respect to claims 38 and 48, Appellant argues in substance that the references clearly teach against each other and the examiner is employing improper hindsight. Appellant argues that the claimed invention as a whole, "seeks to turn traditional paper coupons into virtual coupons and eliminate the fraud associated with consumer-selection of electronic coupons, Christensen teaches the opposite, having consumers select virtual coupons for printing onto a paper list that is scanned for redemption to eliminate the fraudulent use of traditional paper coupons". Furthermore, Appellant argues that "nowhere does Christensen teach or suggest Internet review of unutilized coupon information in a consumer's account".

In response;

The fact that Christensen teaches that consumers select virtual coupons for printing onto a paper list that is scanned for redemption to eliminate the fraudulent use of traditional paper coupons is irrelevant. The examiner did not rely on Christensen to teach the printing of coupons, Christensen was relied upon to the use of Internet to review unutilized coupon information in a consumer's account based on input of a consumer's consumer identification means, Nichtberger et al. already teach the step of providing unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means. Christensen was introduces to teach the step of reviewing these coupons on the Internet, (column 11, line 62 thru column 15, line 36). The end of column 14 thru column 15, Christensen states that;

“The coupon list may be provided, however, with a bar code or other computer-readable indicia corresponding to a consumer's code number or numbers. Thus, if a consumer has not previously signed up for a store's frequency card program, the consumer may use the coupon list as a `temporary` frequency card. The bar code may be scanned at check-out and read by a store computer to apply virtual coupon discounts. If the consumer has not already requested a frequency card, the act of scanning the consumer bar code at check-out may trigger a mailing of a frequency card to the consumer.

To prevent coupon fraud, when each discounted product is purchased, an individual consumer's Virtual Coupon.TM. database may be updated to reflect that a Virtual Coupon.TM. has been redeemed. An individual consumer's Virtual Coupon.TM. database may allow for one, two, or more redemptions of a particular Virtual Coupon.TM. value before such Virtual Coupon.TM. has expired. Moreover, an individual consumer's Virtual Coupon.TM. database may automatically "expire" Virtual Coupons.TM. upon a predetermined expiration date or at the end of a predetermined expiration period.

As no paper coupons are exchanged, coupon replication and fraud, either by consumers or retailers is virtually eliminated. As each Virtual Coupon.TM. redemption may be tied to a particular consumer's Virtual Coupon.TM. database, fraudulent redemption, even on an electronic level (e.g., by computer hacking or the like) may be difficult and time consuming and more readily detected.

To prevent consumers from merely using the frequency card as a way of obtaining windfall savings, Virtual Couponing.TM. may be provided with a feedback mechanism to encourage the consumer to make conscious coupon purchase choices. As noted above, bar codes may be provided on the Virtual Coupon.TM. list such that a consumer must present such a list to a cashier at checkout to receive Virtual Coupon.TM. discounts.

In an on-line embodiment (e.g., BBS, Internet, or the like) a consumer may provide coupon feedback information via an on-line connection to enable Virtual Coupon.TM. discounts within an individual consumer's Virtual Coupon.TM. database. By encouraging a consumer to enable individual Virtual Coupons.TM., the consumer is encouraged to shop for those particular items, rather than merely collect such discounts as a windfall. In-store computer kiosks may be provided to allow a consumer to log into his or her Virtual Coupon.TM. account (e.g., by inserting the SELLECTSOFT.TM. diskette) to check on available Virtual Coupon.TM. discounts, print a shopping list, and select Virtual Coupons.TM. for redemption".

This clearly shows that Christensen teaches the Internet review of unutilized coupon information in a consumer's account", which is the only feature relied upon by Christensen. The motivation to combine the references clearly is mentioned in Christensen (column 13, lines 14-50), the examiner motivation statement states, "because it provides convenience to the user by allowing the user to access coupons of interest quickly by performing a word search, and review, select, and retrieve coupon information directly from the operations center (see Christensen column 13, lines 14-50)".

The examiner respectfully directs the Board's and Appellant's attention to the teachings of Nichtberger which is the combination of presenting coupons to the consumer

electronically (abstract) and scanning paper coupons using a scanner that reads UPC codes on paper coupons (column 29, lines 56-57).

With respect to the De Lapa et al. reference, it was relied upon to teach the step of entering unutilized coupon information from a printed coupon is the only means provided to enter coupons into a consumer account by using a scanner to scan a UPC code (column 9, lines 32 thru column 12, line 34). Nichtberger al. already teaches that consumers can add unutilized coupon information to their accounts using a scanner to scan a UPC code on a paper coupon (column 29, lines 56-68). This section of Nichtberger et al. (column 29, lines 56-68), clearly provide the motivation to combine both references since Nichtberger teaches both steps of entering coupons to the consumers account electronically and manually. One of ordinary skilled in the art would be motivated to do so because, it greatly improves the efficiency of the system by substantially reducing redemption and clearing costs, reducing fraud by destroying paper coupons by the CDR unit once inserted and read, also, it would integrate currently used system into the invention (see Nichtberger column 29, lines 56-68).

Nichtberger et al. teaches both steps of entering unutilized coupons information by a consumer to the consumers account electronically and manually (abstract, and column 29, lines 56-68), and Appellant's disclosure also uses the same methods (specification, page 12, lines 10-11).

For the above reasons, it is respectfully submitted that the rejections should be sustained.

Respectfully Submitted,


HANI M. KAZIMI
PRIMARY EXAMINER
Hani Kazimi

Art Unit 3624

October 2, 2005

Conferees

Vincent Millin 

Richard Weisberger 